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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/922,182
Filing Date: August 02, 2001
Appellant(s): PLOW ET AL.

John L. Rogitz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 11, 2004, appealing from the Office action mailed December 23, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

6,317,761 Landsman et al. 11-2001

6,336,099	Barnett et al.	01-2002
2002/052925	Kim et al.	05-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 4, 6, 7, 8, 10, 11, 13, 14, 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Pub. No. 2002/0052925 to Kim et al.

The Kim '925 patent publication discloses a method of storing Internet advertisements at a user computer. The method comprises automatically receiving plural Internet advertisements (¶69), saving the plural advertisements at the user's computer (¶75), allowing a user to access the saved advertisements in an advertising history window (¶¶77-8), allowing a user to filter previously displayed advertisements (¶¶106-108), wherein the saved advertisement includes a link to a website (¶106), recalling the saved advertisement, and accessing the website.

Regarding claim 3, 4, 6, 10, 11, 13, 16, 17, 18, 19: The method further comprises displaying a button and displaying an advertisement in response to the button being toggled (¶110). The browser (Fig. 12) has a scroll function. The button is a previous and next button (i.e., "Back" and "Forward").

Claims 2, 9, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Pub. No. 2002/0052925 to Kim et al.

The Kim '925 patent publication discloses the claimed invention, as stated in paragraph 3 above, except for the advertisement including an HTML tag. The Kim '925 patent publication

clearly states that the advertisements include URLs (¶106), and the publication further discloses that the advertisements may be in HTML format (¶77). Thus, in view of the disclosure of the Kim publication, it would be obvious to one having ordinary skill in the art to have provided the URLs in HTML format. Furthermore, it is notorious to those familiar with the Internet to use HTML for web-based software.

Claims 1-4, 6-11, 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,336,099 to Barnett et al. in view of U.S. Patent 6,317,761 to Landsman et al.

The Barnett '099 patent discloses a method and system for storing and viewing Internet advertisements. Col. 8, lines 15-22. (While Barnett discloses the coupon packages file as comprising coupons and "other types of advertising materials," coupons themselves are advertisements.) The method and system comprise receiving a plurality of advertisements and saving the advertisements at the user computer. Col. 8, lines 29-34. The advertisements are received automatically. Col. 5, lines 35-46 (updating coupons automatically). The user can access the saved advertisements in an advertisement history window and can filter previously displayed advertisements so that only advertisement corresponding to selected attributes will be displayed. Col. 9, lines 1-33; Fig. 2. The method and system further comprise displaying the advertisements in response to the user toggling a display button. Figs. 2 and 4B. The advertisements are available offline. Fig. 4B. What the Barnett '099 patent does not disclose is that the advertisements include HTML tags and that the advertisements are viewed in a browser window that can click on the tags to access a website. The Landsman '761 patent also discloses a method for storing and viewing Internet advertisements. Furthermore, the Landsman '761 patent teaches that it is known to automatically provide advertisements to a user without a user

requesting them. The method comprises receiving plural Internet advertisements (col. 9, lines 56-58), with at least one Internet advertisement including a HTML tag (col. 9, line 64), and saving (col. 10, lines 12-24) the advertisements at the user computer at least partially based on the tag. The advertisements are viewed using browser software such as INTERNET EXPLORER or NETSCAPE (col. 16, lines 34-39); thus, the method and system of Landsman inherently comprises logic means for displaying the ads in response to toggled buttons, allowing the user to scroll through the advertisements, and displaying a "previous" and "next" button and accessing the advertisements in response to the toggling of these buttons since these are notoriously inherent functions of the aforementioned browser software. The saved advertisement also has a link to a website, and the website is accessed when the link on the advertisement is toggled (col. 17, lines 27-36). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the browser-based advertisement display system and method disclosed in Landsman into the downloadable advertisement method and system disclosed by Barnett, in order to provide the users of the Barnett advertisement system with a familiar interface and an ability to access further advertisement information through the hyperlinked tags.

(10) Response to Argument

Rejection based on Kim (U.S. Patent Application Pub. No. 2002/0052925)

Appellant's first disputes whether Kim is available as prior art. The nonprovisional application filing date of the Kim publication is after the filing date of the instant application, but Kim claims priority to a provisional application, 60/228,690, bearing a filing date *before*

Appellant's instant application. Therefore, in accordance with M.P.E.P., the 35 U.S.C. 102(e) critical reference date of the Kim publication is the filing date of the provisional application "if the provisional application properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph." M.P.E.P. §2136.03(III). In the Office action of 12/23/04, the examiner confirmed that it was his belief that the provisional application did in fact provide full support for the relied-on portions of the Kim publication. Until this point, Appellant has never identified any particular portions of the Kim publication that he believes are unsupported by the provisional application.

Instead, Appellant asserted, and asserts now, that it is the examiner's burden to prove the provisional application provides written description support. See Brief at 5, and Response to Office Action, received 10/20/04, at 1-2. The examiner respectfully submits that this assertion contorts the framework for M.P.E.P. §2136.03(III). That section of the M.P.E.P states that the critical reference date of a nonprovisional patent publication is the filing date of the provisional application if the provisional application provides 112(1) support. The burden of proof for the written description requirement of 35 U.S.C. 112(1) lies with the person arguing that a written description is inadequate. During examination, the examiner bears the burden to prove lack of written description support for the application being examined. See M.P.E.P. §2163.04. In an infringement action involving an invalidity defense, the party asserting invalidity based on 35 U.S.C. 112 bears the burden to prove lack of written description support for the patent being applied against them. Ralston Purina Co. v. Far-Mar-Co, Inc., 772 F.2d 1570, 1574 (Fed. Cir. 1985). In this case, Appellant is asserting that the Kim publication is not adequately supported

by the provisional application. The Appellant bears the burden to prove that the Kim publication is not entitled to the critical reference date.

Now, for the first time, Appellant submits in his opening brief conclusory arguments that paragraphs 75, 77, 78, 106-108, 110 and Figures 11 and 12 of the Kim publication are not supported by Kim's provisional application. Appellant does not state specifically how he thinks those sections are not supported, so there is no precise arguments for the examiner to address. Thus, Appellant has not met his burden of proof, and Kim should be accorded a critical reference date of the provisional application's filing date.

Regardless, Appellant's general arguments are incorrect; the Kim provisional application fully supports the relied-on portions of the Kim publication. The following chart illustrates how each step of Appellant's claim 1 is disclosed by the Kim publication and, in turn, how the relied-on portions of the Kim publication are supported by the Kim provisional application:

Appellant's Claim 1	**Kim Patent Application Pub. No. 2002/0052925**	**Kim Provisional application 60/228,690**
A method for storing Internet advertisements at a user computer, comprising the acts of:	A system and method for delivering Internet advertisements. The system and method comprise downloading and storing advertisements at a user's computer. Abstract	"A method of delivering information including...advertising content." The method comprises downloading the advertising content. Pg. 1, ¶1.
receiving plural Internet advertisements at the users computer automatically without the user requesting them;	"The users of the client do not request the information [advertisements] positively." Pg. 4, ¶69.	"Client [i.e., the software] then retrieves the messages [advertisements] autonomously." Pg. 9, ¶1.
saving at least plural advertisements at the user	"The present invention downloads information,	"To show the message [advertisement]

computer;	typically ADs, in advance in the local storage of the client to show the information instantaneously upon a mouse click." Pg. 5, ¶75.	instantaneously upon a mouse click, the computer filed containing the message must be present in advance in the local storage. The advertising files are downloaded while the user activity is low." Pg. 9, ¶2
allowing a user to access saved advertisements in an advertising history window displaying Internet content composed of plural advertisements;	"[T]he client software presents the information in full-browser mode." "The present invention uses a virtual browser to display the information." Pg. 6, ¶¶77-78.	"In this present invention, full-browser based one-click instant presentation is used." Pg. 9, ¶3.
allowing a user to filter previously displayed advertisements, so that only advertisements corresponding to one or more user selected attributes are eligible for display;	ADs are cataloged under hierarchical categories, which are previously displayed ADs (pool_A), displayed ADs to be deleted automatically (pool_C), and user selected ADs to be saved (pool_D). A user filters previously displayed advertisements by selecting an AD to be moved to pool_D; only those previously displayed ADs in pool_D are eligible for display, since the others are deleted automatically. Pg. 8, ¶107.	"Each e-catalog entries [each advertisement] have expiration date for automatic deletion, but users can control the entries to store permanently or delete it." "When the user clicks an entry the advertising is played or the attached catalog message can be viewed." Pg. 12, ¶1.
wherein the saved advertisements include at least one link to a website and the method further comprises:	The advertisements include "a website whose URL is embedded in the AD." Pg. 8, ¶106.	"The physical format of the message [advertisement] could be various, including multimedia animation, video, banner, static image, HTML page, letters etc. In other words, **any format that is supported by the web browser** can be presented using the invented method. Pg. 10, ¶1 (emphasis added).
recalling a user-selected saved advertisement, the saved advertisement having at least one link to a website; and	"[I]f the [advertisement] information is useful for the user, the user may choose to save the AD permanently in	"[T]he E-catalog helps the end-users backtrack the previous AD and to collect product information." Pg. 12,

accessing the website from the saved advertisement when the link is toggled.	the e-catalog." "The user can also positively invoke the e-catalog." Pg. 8, ¶¶107-108. A website's URL "is embedded in the AD." Pg. 8, ¶106.	¶4. Part of this product information comes from a user's interaction with a AD sponsor's web page. Pg. 11, ¶4.

The above chart summarizes how the Kim provisional application literally supports the relied-on portions of the Kim publication. Actually, this is not the test. The correct test for determining whether a parent application provides sufficient written description support is "whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" Ralston Purina Co., 772 F.2d at 1575 (Fed. Cir. 1985) (citing In re Kaslow, 707 F.2d 1366, 1375 (Fed. Cir. 1983)). Having met the more stringent test, the Kim publication certainly meets the more lenient test. An ordinary artisan would reasonably find that the relied-on portions of the Kim publication are supported by Kim's provisional application.

Appellant also incorrectly argues that the Kim publication does not disclose an advertising history window displaying Internet content composed of plural advertisements. First, Appellant misreads the scope of his own claims. Claim 1 is open to several interpretations. For example, claim 1 does not require the advertising history window to display plural advertisements **simultaneously**; rather, the claim only recites that the advertising history window displays plural advertisements. Assuming *arguendo* that the advertising history window of the Kim publication only displays one advertisement at a time, Kim's advertising history window still displays plural advertisements by displaying them sequentially. Furthermore, Fig. 12 of the Kim publication (and Fig. 9 of the provisional application) clearly discloses a browser showing a

plurality of advertisements in the left-hand window (similar to Internet Explorer's "Favorite's" window).

Second, Appellant cannot rely on a claim construction that the advertising history window shows plural advertisements simultaneously because, as noted in the Office action of 12/23/04, Appellant does not have written description support for this construction. Appellant's Fig. 3, which is remarkably similar to Kim's Figs. 15-16, is illustrative. This figure shows that the browser history window displays a plurality of ads in the menu portion (48). Though a plurality of ads can be displayed in the menu portion, only one ad is graphically displayed at a time. See "Ad History Window 50." See also Appellant's specification, page 7, lines 11-12 ("[C]aptured ads can be presented to the user one at a time within an "Ad History" window 50...."). Nothing else in Appellant's specification suggests otherwise. Appellant only has written description support for a browser exactly like that shown in Kim. Appellant's opening brief does not address this issue. Despite the examiner raising this issue in the last Office action, Appellant has not addressed it in his opening brief.

Rejection under 35 U.S.C. 103(a) based on U.S. Patent No. 6,336,099 to Barnett et al. and U.S. Patent No. 6,317,761 to Landsman et al.

Appellant's arguments with respect to the Barnett patent again suffer from the problem that Appellant is arguing beyond the scope of his claim. Appellant uses the transitional phrase "comprising" in the preamble of independent claims 1, 7, and 14; thus, Appellant's claims are open-ended and do not exclude additional method steps. See M.P.E.P. §2111.03. Barnett discloses additional steps not present in Appellant's claims, namely, the downloading of the

initial coupon packages file. But Barnett also discloses that the coupons are updated automatically. Col. 5, lines 39-46. Updating a coupon, such as by changing the redemption value of the coupon, results in a quantitatively different advertisement than previous existed. For example, the initial coupon packages file of the Barnett patent may offer $5 off for the purchase of a particular item. If the $5 coupon does not result in sufficient business, a merchant may decide to change the value, increasing it to $10. Although the $10 coupon may be in the same format as the $5 coupon, it is a different advertisement (i.e., $10 off, instead of $5 off). In fact, Barnett teaches that coupon values should be varied to appeal to certain prospective buyers and that the ability to vary the value coupons (automatically, as stated above) "is a unique advantage offered by the [Barnett] system...." See col. 13, lines 31-42. Thus, Barnett implicitly recognizes that coupons of different values are different advertisements designed to appeal to distinct customers.

Appellant also mischaracterizes the Barnett patent by suggesting that the Barnett patent is limited to coupons "intended to be printed out and redeemed." Brief at 7-8. Barnett explicitly states otherwise. While printed coupons are certainly a feature of the Barnett patent, Barnett also contemplates that the coupons data may be used electronically, with no printing. See, e.g. col. 4, line 66 – col. 5, line 2 ("Alternatively, the system may enable the user to transmit **electronically** the printable coupon data...for **electronic coupon redemption**."), and col. 11, lines 35-37 ("[T]he coupon may be redeemed **electronically**....") (emphasis added).

Barnett does not disclose that the coupons are viewed in a browser that enables a user to click on a link in the coupons to access a website. Barnett, in fact, is largely silent about the type of display screen through which coupons are viewed, only noting that the display screen has a

scrolling ability and is responsive to mouse or keyboard input. See col. 9, lines 59-64. Furthermore, Barnett discloses that the coupons can include "graphics, text, recipes, competitions or other inducements or a combination thereof." Conceivably, a link to a website with more information might be one type of graphical inducement, but Barnett does not provide any additional details about the type of browser or the content of the coupons.

The Landsman patent teaches another advertising system in which advertisements are viewed and stored at a user's computer. Landsman, however, explicitly discloses that the advertisements are viewed using INTERNET EXPLORER or NETSCAPE. See Landsman, col. 16, lines 34-39. Landsman further discloses that the advertisements have links to a website and that the website is accessed when the link is toggled. See col. 17, lines 27-36. These features of Landsman – a traditional browser and links to websites – are familiar features to Internet users, and one of ordinary skill in the computer method arts would readily recognize that familiarity in a computer application's user interface is often the linchpin for the widespread use and success of that application. Thus, an ordinary artisan would find it obvious to take the coupon system of the Barnett patent and to provide it with a traditional browser (such as NETSCAPE or EXPLORER) and website links, as taught by the Landsman patent, in order to provide a familiar interface and to enable a customer to obtain further advertisement information.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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